



Atty. Docket No. LEG03 P-317

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Art Unit : 3679
Examiner : James M. Hewitt
Applicants : Scott C. Young et al.
Appln. No. : 10/061,699
Filed : February 1, 2002
Confirmation No. : 1548
For : SWIVEL DROP EAR ELBOW FITTING

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APPELLANTS' BRIEF (37 CFR §1.192)

This brief is in furtherance of the Notice of Appeal, filed in this case on November 13, 2003.

The fees required under §1.17(c), and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is filed in triplicate. (37 CFR §1.192(a)).

This brief contains these items under the following headings, and in the order set forth below (37 CFR §1.192(c)):

- I. Real Party in Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Invention
- VI. Issues
- VII. Grouping of Claims

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VIII. Argument

- A. Marshall Brass' Part No. F21B34.
- B. Marshall Brass' Part No. F26B44.
- C. U.S. Patent No. 3,376,053 to Novakovich.
- D. U.S. Patent No. 2,373,253 to Martin.
- E. U.S. Patent No. 5,305,785 to Humber.
- F. Legal Considerations

IX. Conclusion

Appendix of Claims (double spaced) Involved in the Appeal

The final page of this brief bears the attorney's signature.

I. Real Party in Interest

The real party in interest in this application is S.H. Leggitt Company.

II. Related Appeals and Interferences

Appellants are aware of no appeals or interferences that would directly affect or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

III. Status of Claims

This is an appeal from a Final Rejection of claims 1-20 of the above-identified application. Appealed claims 1-20 are attached in the Appendix hereto.

IV. Status of Amendments

The claims were not amended after the Final Rejection, mailed August 13, 2003, and stand as amended on June 6, 2003.

V. Summary of the Invention

As is best shown in Figs. 1 and 3 (see paragraphs 19 and 20), the present invention is directed to a swivel drop ear elbow fitting 100 that includes a threaded nut 102 and a hollow elbow adapter 110. The threaded nut 102 includes a plurality of integrated attachment ears 104a,

104b and 104c, which include apertures 106a, 106b and 106c, respectively, for receiving fasteners for securing the threaded nut 102 to a stationary support, for example, a board horizontally positioned between two upright wall studs. Alternatively, as is shown in Fig. 8, threaded nut 102A may be fashioned as a mounting ring including apertures 107.

With specific reference to Fig. 3, according to one embodiment of the present invention, a retaining ring 112 is in contact with an outer surface of a first portion 110b of the hollow elbow adapter 110. In this embodiment, a seal 116 is positioned on the first portion 110b, that extends beyond the retaining ring 112, of the hollow elbow adapter 110. The retaining ring 112 includes a flange 112a that extends along the inner periphery of the retaining ring 112. The flange 112a digs into an outer surface of the first portion 110b to counteract a force, which could separate the threaded nut 102 and the hollow elbow adapter 110. In at least one embodiment, a second portion 110a of the hollow elbow adapter 110 includes a plurality of axially aligned ribs 114, which are utilized to retain a plastic tube that is slid over an outer surface of the second portion 110a.

VI. Issues

The issues are:

A. The first issue on appeal is whether claims 1, 2, 4, 6-8, 10, 11, 13 and 15-16 are patentable under 35 U.S.C. §103(a) over the combination of Marshall Brass' Part Nos. F21B34 and F26B44.

B. The second issue on appeal is whether claims 3 and 12 are patentable under 35 U.S.C. §103(a) over the combination of Marshall Brass' Part Nos. F21B34 and F26B44 in view of U.S. Patent No. 3,376,053 to Novakovich.

C. The third issue on appeal is whether claims 5 and 14 are patentable under 35 U.S.C. §103(a) over the combination of Marshall Brass' Part Nos. F21B34 and F26B44 in view of U.S. Patent No. 2,373,253 to Martin.

D. The fourth issue on appeal is whether claim 9 is patentable under 35 U.S.C. §103(a) over the combination of Marshall Brass' Part Nos. F21B34 and F26B44 in view of U.S. Patent No. 5,305,785 to Humber.

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E. The fifth issue on appeal is whether claims 17, 18 and 20 are patentable under 35 U.S.C. §103(a) over the combination of Marshall Brass' Part Nos. F21B34 and F26B44 in view of U.S. Patent No. 5,305,785 to Humber and in further view of U.S. Patent No. 3,376,053 to Novakovich.

F. The sixth issue on appeal is whether claim 19 is patentable under 35 U.S.C. §103(a) over the combination of Marshall Brass' Part Nos. F21B34 and F26B44 in view of U.S. Patent No. 5,305,785 to Humber and in further view of U.S. Patent No. 3,376,053 to Novakovich and still in further view of U.S. Patent No. 2,373,253 to Martin.

VII. Grouping of Claims

For purposes of this appeal, claims 1-20 can be placed in a single group and stand or fall together.

VIII. Arguments

In the arguments provided below, Appellants briefly discuss each of the cited references, followed by Appellants' legal arguments as to why a *prima facie* case of obviousness of claims 1-20 has not been established based upon the combination of Marshall Brass' Part Nos. F21B34 and F26B44 and in view of U.S. Patent No. 3,376,053 to Novakovich, U.S. Patent No. 2,373,253 to Martin and U.S. Patent No. 5,305,785 to Humber.

A. Marshall Brass' Part No. F21B34.

Marshall Brass' Part No. F21B34 (hereinafter F21B34) is an elbow swivel assembly fitting that has a 3/8 inch PEX termination and a 1/2 inch threaded termination. The F21B34 includes a 1/2 inch nut that is retained on a first portion of the elbow adapter by a retaining ring. A seal is positioned over the first portion of the elbow adapter and within the nut. Three ribs extend from an outer surface of the nut to facilitate hand-tightening of the nut.

B. Marshall Brass' Part No. F26B44.

Marshall Brass' Part No. F26B44 (hereinafter the F26B44) is a drop ear elbow fitting that has a 1/2 inch PEX termination and a 1/2 inch threaded termination. Three mounting ears, which extend from a lower body of the fitting, are used to affix the fitting to a structure, such as a wall.

C. U.S. Patent No. 3,376,053 to Novakovich.

Novakovich Fig. 4 discloses an elbow fitting that includes a first portion and a second portion that are connected at an obtuse angle.

D. U.S. Patent No. 2,373,253 to Martin.

Martin discloses a straight threaded fitting that includes a washer 18 (see Fig. 3). The washer 18, a sealing ring 22 and metallic sealing rings 23 and 24 are assembled into a recess 15 of a nut 13, which is threaded onto an arm portion 3 of a fitting.

E. U.S. Patent No. 5,305,785 to Humber.

Humber discloses a plumbing installation that includes an outlet box, at least one water supply pipe extending into the box and a torque inhibiting connection between the pipe and a boiler drain valve positioned in the interior of the box. The assembly utilizes a compression nut 32 (see Fig. 2).

F. Legal Considerations

1. REJECTION OF CLAIMS 1, 2, 4, 6-8, 10, 11, 13 AND 15-16 UNDER
35 U.S.C. §103(a)

With respect to issue A, Appellants respectfully submit that the Examiner has failed to establish *prima facie* obviousness of the claimed invention recited in claims 1, 2, 4, 6-8, 10, 11, 13 and 15-16 based on the combination of Marshall Brass' Part Nos. F21B34 and F26B44. Section 2143 of the latest revision of the Manual of Patent Examining Procedure (MPEP) states the following regarding the requirements for establishing a *prima facie* case of obviousness:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

At the outset, Appellants submit that neither the F21B34 nor the F26B44 provide any suggestion or motivation for the combination of the references. In the Advisory Office Action, mailed October 29, 2003, the Examiner stated "providing apertures in the ears of the F21B34 termination would allow the F21B34 termination to be fixedly secured to a wall as by fasteners. This modification does not make the F21B34 termination inoperable. The nut would be threadedly attached to a fitting or attachment on a wall, and fasteners would secure the fitting to the wall, thus creating a fixed and more secure connection between the nut and fitting and between the nut and the wall. To remove the F21B34 termination, the fasteners (screws) would be removed, and the nut would be unscrewed. The nut can still be unthreaded and replaced or unthreaded and re-installed. The fasteners would just have to be removed first." However, Appellants still maintain that the Examiner's reasoning is flawed and appears to be based on impermissible hindsight reasoning as the ribs of the F21B34 nut function to facilitate hand-tightening of the nut and not to secure the F21B34 fitting to a wall.

In the Advisory Office Action, the Examiner refuted Applicants' assertion of impermissible hindsight reasoning by referring Applicants to page 11 of the Final Office Action. At page 11 of the Final Office Action, mailed August 13, 2003, the Examiner stated "[t]he fasteners, being disposed through the apertures and attached to the support, could act to prevent unwanted rotation of the nut, essentially making a fixed connection; after the nut were threadedly connected to an attachment, the connection could be made fixed by disposing the fasteners through the apertures and into a support." However, Appellants submit that this statement misses the point as the F21B34 nut was designed to rotate to facilitate connection of the F21B34 fitting to an externally threaded fitting.

In the Advisory Office Action, the Examiner also stated “both the F21B34 and F26B44 devices are elbow fittings. Both include an internally threaded nut and a barb portion projecting orthogonal to the axis of the nut. The F26B44 fitting teaches apertured ears attached to the body of the nut in order to allow the nut to be affixed to a support by a fastening means. The F21B34 fitting includes projections or ears which are attached to the body of the nut. Thus, given the teaching of the F26B44 fitting, it would have been obvious at the time the invention was made to provide apertures in the ears of the F21B34. This modification would be plainly obvious to the skilled artisan.” Appellants specifically note that the body of the F26B44 fitting is threaded and does not include a “threaded nut,” as asserted by the Examiner. Appellants further note that the F26B44 fitting does not have “apertured ears attached to the body of the nut,” as asserted by the Examiner, as the F26B44 fitting does not include a nut. At the most, the F26B44 fitting provides motivation to integrate apertured ears on a body of the F21B34 fitting.

Further, Appellants note that the Examiner has not addressed Appellants’ comments that rotating an external fitting to secure the F21B34 termination (modified as suggested by the Examiner) to the external fitting changes the principle of operation of the F21B34 termination. As noted above, the Examiner has specifically admitted that in order to remove the F21B34 termination (modified as set forth by the Examiner), the fasteners or screws would be removed and the nut would be unscrewed. In sum, Appellants submit that the principle of operation of the F21B34 termination, when modified as suggested by the Examiner, is changed, as is specifically prohibited by MPEP §2143.01. MPEP §2143.01 states:

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”

Further, MPEP §2143.01 states:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious.

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In sum, it is Appellants' position that modifying the F21B34 fitting, as proposed by the Examiner, renders the F21B34 fitting unsatisfactory for its intended purpose and changes its principle of operation. For at least these reasons, Appellants submit that the rejection of claims 1-2, 4, 6-8, 10-11, 13 and 15-16 under 35 U.S.C. §103(a) is in error and should be overturned.

2. REJECTION OF CLAIMS 3, 5, 9, 12, 14 AND 17-20 UNDER 35 U.S.C. §103(a)

With respect to issues B-F, as the Examiner has not established a *prima facie* case of obviousness of independent claims 1 and 10, the rejection of claims 3, 5, 9, 12, 14 and 17-20 is also in error and should also be overturned.

IX. Conclusion

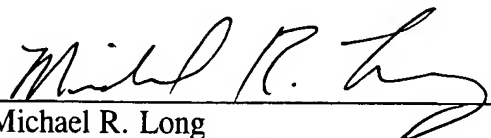
For the reasons set forth above, and as apparent from examining the invention defined by claims 1-20, when the cited references are properly considered, Appellants' claims 1-20 define patentable subject matter. Accordingly, reversal of the rejections of the claims under 35 U.S.C. §103(a) is appropriate and is respectfully solicited.

Respectfully submitted,

SCOTT C. YOUNG ET AL.

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Appendix of Claims (37 CFR §1.192(c)(9))

1. A swivel drop ear elbow, comprising:

a threaded nut including a plurality of integrated attachment ears located along an external periphery of the threaded nut, wherein each of the attachment ears includes an aperture for receiving a fastener for securing the threaded nut to a stationary support;

a retaining ring; and

a hollow elbow adapter including a first portion centrally positioned with respect to a first axis and a second portion centrally positioned with respect to a second axis, wherein the second axis is not parallel to the first axis, and wherein an outer surface of the first portion of the elbow adapter is shaped to receive the retaining ring which retains the threaded nut on the first portion of the hollow elbow adapter.

2. The swivel drop ear elbow of claim 1, wherein the first axis is substantially orthogonal with respect to the second axis.

3. The swivel drop ear elbow of claim 1, wherein the first axis forms an obtuse angle with respect to the second axis.

4. The swivel drop ear elbow of claim 1, wherein the plurality of integrated attachment ears includes three attachment ears that are equally spaced along the external periphery of the threaded nut.

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5. The swivel drop ear elbow of claim 1, wherein the retaining ring is a grooveless retaining ring.

6. The swivel drop ear elbow of claim 1, wherein an outer surface of the second portion of the hollow elbow adapter includes a plurality of axially spaced ribs.

7. The swivel drop ear elbow fitting of claim 1, further including:

a seal with an inner diameter sized to receive the first portion of the hollow elbow adapter and an outer diameter sized to substantially eliminate fluid leakage between the elbow fitting and an external fitting that is threadingly received by the threaded nut.

8. The swivel drop ear elbow of claim 7, wherein the seal is a cone shaped seat made of an elastomeric material.

9. The swivel drop ear elbow of claim 1, wherein the threads of the threaded nut are straight threads.

10. A swivel drop ear elbow fitting, comprising:

a threaded nut including a plurality of integrated attachment ears located along an external periphery of the threaded nut, wherein each of the attachment ears includes an aperture for receiving a fastener for securing the threaded nut to a stationary support;

a retaining ring;

a hollow elbow adapter including a first portion centrally positioned with respect to a first axis and a second portion centrally positioned with respect to a second axis, wherein the second axis is not colinear with the first axis, and wherein an outer surface of the first portion of the elbow adapter is shaped to receive the retaining ring which retains the threaded nut on the first portion of the hollow elbow adapter while allowing the hollow elbow adapter to rotate with respect to the threaded nut; and

a seal with an inner diameter sized to receive the first portion of the hollow elbow adapter and an outer diameter sized to substantially eliminate fluid leakage between the elbow fitting and an external fitting that is threadingly received by the threaded nut.

11. The swivel drop ear elbow of claim 10, wherein the first axis is substantially orthogonal with respect to the second axis.

12. The swivel drop ear elbow of claim 10, wherein the first axis forms an obtuse angle with respect to the second axis.

13. The swivel drop ear elbow of claim 10, wherein the plurality of integrated attachment ears includes three attachment ears that are equally spaced along the external periphery of the threaded nut.

14. The swivel drop ear elbow of claim 10, wherein the retaining ring is a grooveless retaining ring.

15. The swivel drop ear elbow of claim 10, wherein an outer surface of the second portion of the hollow elbow adapter includes a plurality of axially spaced ribs.

16. The swivel drop ear elbow of claim 10, wherein the seal is a cone shaped seat made of an elastomeric material.

17. A swivel drop ear elbow, comprising:

a threaded nut including a plurality of integrated attachment ears located along an external periphery of the threaded nut, wherein each of the attachment ears includes an aperture for receiving a fastener for securing the threaded nut to a stationary support, and wherein the threads of the threaded nut are straight threads;

a retaining ring;

a hollow elbow adapter including a first portion centrally positioned with respect to a first axis and a second portion centrally positioned with respect to a second axis, wherein the second axis is one of substantially orthogonal to the first axis and forms an obtuse angle with respect to the first axis, and wherein an outer surface of the first portion of the elbow adapter is shaped to receive the retaining ring which retains the threaded nut on the first portion of the hollow elbow adapter; and

a cone shaped seat made of an elastomeric material with an inner diameter sized to receive the first portion of the hollow elbow adapter and an outer diameter sized to

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substantially eliminate fluid leakage between the elbow fitting and an external fitting that is threadingly received by the threaded nut and the swivel drop ear elbow.

18. The swivel drop ear elbow of claim 17, wherein the plurality of integrated attachment ears includes three attachment ears that are equally spaced along the external periphery of the threaded nut.

19. The swivel drop ear elbow of claim 17, wherein the retaining ring is a grooveless retaining ring.

20. The swivel drop ear elbow of claim 17, wherein an outer surface of the second portion of the hollow elbow adapter includes a plurality of axially spaced ribs.